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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/419,246	10/15/1999	KENZO SEKIGUCHI	862.3071	9956
5514	7590	12/28/2004		
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			EXAMINER POKRZYWA, JOSEPH R	
			ART UNIT 2622	PAPER NUMBER

DATE MAILED: 12/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/419,246

Applicant(s)

SEKIGUCHI ET AL.

Examiner

Joseph R. Pokrzywa

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-14, 21-28, 35, 45, 47, 50, 52, 69 and 73-75 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 7-14, 21-28, 35, 45 and 50 is/are allowed.
- 6) ☒ Claim(s) 47, 52, 69 and 73-75 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/16/04 has been entered.

Response to Amendment

2. Applicant's amendment was received on 7/12/04, and has been entered and made of record. Currently, **claims 7-14, 21-28, 35, 45, 47, 50, 52, 69, and 73-75** are pending.

Response to Arguments

3. Applicant's arguments, with respect to claims 47, 52, and 69, filed 7/12/04 have been fully considered but they are not persuasive.

4. In response to applicant's arguments regarding the rejection of claim 47, cited in the Office action dated 4/7/04 as being unpatentable over Shaffer *et al.* (U.S. Patent Number 6,092,114) in view of Saito *et al.* (U.S. Patent Number 6,351,316), whereby on pages 16 and 17 applicant argues that the combination fails to teach of determining the language type of a source from header information of the electronic mail received by the receiving unit, and electronic mail indicating the conversion error is generated by a message corresponding to the determined

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language type. Applicant further adds on page 17 that the current invention, as claimed, would generate a report by using the detected language type of the source of the received data, *thus enabling the sender of the data to read the report written in his/her language*. This aspect of the argued invention is not currently found in the claim, as written. The examiner believes that the claimed "language type" can be interpreted as software language which codes messages in a particular file format.

With this definition of "language type", one of ordinary skill in the art can recognize that Shaffer teaches that a language type of a source is determined *from information* of the electronic mail received by the receiving unit, as read in column 1, line 36 through column 2, line 65, and column 5, line 56 through column 6, line 29, wherein attachments of various file formats are determined, thus determining a software language type of a source. Further, Shaffer teaches that electronic mail indicating a conversion error is generated by a message corresponding to the determined software language type, as seen in step 54, column 5, lines 14 through 43, and column 6, line 30 through column 7, line 38.

However, as discussed in the Office action dated 4/7/04, Shaffer fails to expressly disclose if the language type **is determined from header information**. Saito can be seen as teaching that a language type of a source is determined *from header information* of the electronic mail received by the receiving unit, whereby as read in column 3, lines 5 through 11 the "format of an attached file" is indicated in the "Content-Type:" section in the header of an e-mail. Further Saito teaches that a conversion error is generated by a message corresponding to the determined language type, as read in step ST609, column 4, line 62 through column 5, line 6. Because of this, it would have been obvious to one of ordinary skill in the art at the time the invention was

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made to consider the determination of the language type taught by Shaffer be accomplished through identifying the "Content-Type:" in the header, as recognized by Saito.

5. Therefore, the rejection of **claim 47**, as well as the rejection of **claims 52 and 69**, which were cited under 35 U.S.C. 103(a) as being unpatentable over Shaffer *et al.* in view of Saito *et al.* are repeated in this Office action. Further, for similar reasons new **claims 73 and 75** are rejected in this Office action under 35 U.S.C. 103(a) as being unpatentable over Shaffer *et al.* in view of Saito *et al.*

Claim Objections

6. The objections of **claims 7, 21, 47, and 52**, as cited in the Office action dated 4/7/04, are overcome by the amendment dated 7/12/04.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. **Claims 73-75** are rejected under 35 U.S.C. 102(e) as being anticipated by Shaffer *et al.* (U.S. Patent Number 6,092,114, cited in the Office action dated 4/7/04).

Regarding **claim 73**, Shaffer discloses a communication apparatus (local server 12, see Figs. 1 and 2), comprising a receiving unit adapted to receive data sent from a remote sender

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(step 40 in Fig. 2, column 1, lines 36 through 54, and column 5, line 65 through column 6, line 9), a data processing unit adapted to process the data received by the receiving unit (steps 42 and 44 in Fig. 2), a content analyzing unit adapted to detect a language type of the data (steps 46 and 50 in Fig. 2, column 1, line 36 through column 2, line 65, and column 5, line 56 through column 6, line 29, wherein the format of the file is determined, therein detecting a “language type” of the data), a report information generating unit adapted to generate information, relating to the result from the data processing unit, described by the language type detected by the content analyzing unit (step 54, column 5, lines 14 through 43, and column 6, line 30 through column 7, line 38), and an information transmitting unit adapted to transmit the information generated by the report information generating unit to the remote sender (step 54, column 7, lines 29 through 38).

Regarding **claim 74**, Shaffer discloses the apparatus discussed above in claim 73, and further teaches that the content analyzing unit is also adapted to determine whether the data processing unit is capable of processing the detected language type (seen in steps 50 and 52 of Fig. 2).

Regarding **claim 75**, Shaffer discloses a data communication method (see Fig. 2), comprising receiving data sent from a remote sender (step 40 in Fig. 2, column 1, lines 36 through 54, and column 5, line 65 through column 6, line 9), processing the data received in the receiving step (steps 42 and 44 in Fig. 2), detecting a language type of the data (steps 46 and 50 in Fig. 2, column 1, line 36 through column 2, line 65, and column 5, line 56 through column 6, line 29, wherein the format of the file is determined, therein detecting a “language type” of the data), generating information relating to the result from the data processing step, described by the language type detected in detecting step (step 54, column 5, lines 14 through 43, and column 6,

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line 30 through column 7, line 38), and transmitting the information generated in the generating step to the remote sender (step 54, column 7, lines 29 through 38).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. **Claims 47, 52, and 69** are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaffer *et al.* (U.S. Patent Number 6,092,114, cited in the Office action dated 4/7/04) in view of Saito *et al.* (U.S. Patent Number 6,351,316, cited in the Office action dated 4/7/04).

Regarding **claim 47**, Shaffer discloses a communication apparatus (local server 12, see Figs. 1 and 2), comprising a receiving unit adapted to receive electronic mail (column 1, lines 36 through 54, and column 5, line 65 through column 6, line 9), an extracting unit adapted to analyze the electronic mail received by the receiving unit and to extract binary data attached to the electronic mail (column 1, lines 43 through 54, and column 6, lines 6 through 29, seen in step 42, wherein the bitmap data extracted in the attachment is inherently binary data), a converting unit adapted to convert the binary data extracted by the extracting unit into image data (step 52, through format converter 30, column 7, lines 12 through 38), and an output unit adapted to output the image data converted by the converting unit (step 48, column 7, lines 3 through 38), wherein a language type of a source is determined *from information* of the electronic mail received by the receiving unit (column 1, line 36 through column 2, line 65, and column 5, line

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56 through column 6, line 29), and electronic mail indicating the conversion error is generated by a message corresponding to the determined language type (step 54, column 5, lines 14 through 43, and column 6, line 30 through column 7, line 38).

However, Shaffer fails to expressly disclose if the language type of a source is determined **from header information** of the electronic mail received by the receiving unit.

Saito discloses a communication apparatus (see Figs. 3 and 4), comprising a receiving unit adapted to receive electronic mail (step ST601, column 4, lines 30 through 33), an extracting unit adapted to analyze the electronic mail received by the receiving unit and to extract data attached to the electronic mail (column 3, lines 5 through 11), a converting unit adapted to convert the data extracted by the extracting unit into image data (column 3, line 64 through column 4, line 12), and an output unit adapted to output the image data converted by the converting unit (column 3, line 64 through column 4, line 12), wherein a language type of a source is determined from header information of the electronic mail received by the receiving unit (column 3, lines 5 through 11), and a conversion error is generated by a message corresponding to the determined language type (step ST609, column 4, line 62 through column 5, line 6).

Shaffer & Saito are combinable because they are from the same field of endeavor, being systems that receive electronic mail and perform conversion of message attachments. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to include the teachings of Saito in the system of Shaffer. The suggestion/motivation for doing so would have been that Shaffer's system would conform with well known standards of using header information in an electronic mail to identify an attachment's format, as recognized by Saito in

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column 3, lines 5-11. Therefore, it would have been obvious to combine the teachings of Saito with the system of Shaffer to obtain the invention as specified in claim 47.

Regarding **claim 52**, Shaffer discloses a method of forming and outputting image data on the basis of received electronic mail (see abstract, and steps 40 and 48 in Fig. 2, column 6, lines 6 through 19, and column 7, lines 3 through 6), comprising the steps of receiving electronic mail (column 1, lines 36 through 54, and column 5, line 65 through column 6, line 9), analyzing the received electronic mail and extracting binary data attached to the electronic mail (column 1, lines 43 through 54, and column 6, lines 6 through 29, seen in step 42, wherein the bitmap data extracted in the attachment is inherently binary data), converting the extracted binary data into image data (step 52, through format converter 30, column 7, lines 12 through 38), and outputting the converted image data (step 48, column 7, lines 3 through 38), wherein a language type of a source is determined *from information* of the electronic mail received by the receiving unit (column 1, line 36 through column 2, line 65, and column 5, line 56 through column 6, line 29), and electronic mail indicating the conversion error is generated by a message corresponding to the determined language type (step 54, column 5, lines 14 through 43, and column 6, line 30 through column 7, line 38).

However, Shaffer fails to specifically teach if the language type of a source is determined **from header information** of the electronic mail received by the receiving unit.

Saito discloses a method of forming and outputting image data on the basis of received electronic mail (see abstract, and column 1, lines 43 through 52), comprising the steps of receiving electronic mail (step ST601, column 4, lines 30 through 33), analyzing the received electronic mail and extracting data attached to the electronic mail (column 3, lines 5 through 11),

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converting the extracted data into image data (column 3, line 64 through column 4, line 12), and outputting the converted image data (column 3, line 64 through column 4, line 12), wherein a language type of a source is determined from header information of the electronic mail received by the receiving unit (column 3, lines 5 through 11), and a conversion error is generated by a message corresponding to the determined language type (step ST609, column 4, line 62 through column 5, line 6).

Shaffer & Saito are combinable because they are from the same field of endeavor, being systems that receive electronic mail and perform conversion of message attachments. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to include the teachings of Saito in the system of Shaffer. The suggestion/motivation for doing so would have been that Shaffer's system would conform with well known standards of using header information in an electronic mail to identify an attachment's format, as recognized by Saito in column 3, lines 5-11. Therefore, it would have been obvious to combine the teachings of Saito with the system of Shaffer to obtain the invention as specified in claim 52.

Regarding **claim 69**, Shaffer discloses a communication apparatus (local server 12, see Figs. 1 and 2) comprising an input unit adapted to input data (step 40, column 5, line 65 through column 6, line 19), a first determining unit adapted to determine whether the input data is non-image data or image data (step 42, column 5, line 56 through column 6, line 29, wherein the attachment may be an audio file, a video file, or a graphic file), a second determining unit adapted to determine whether the non-image data is *convertible* (step 50, column 6, line 66 through column 7, line 38), a processing unit adapted to perform a converting process if the non-image data is convertible (step 52, column 6, line 66 through column 7, line 15), a content

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analyzing unit adapted to detect a language type from the electronic mail (column 2, line 53 through column 3, line 13, and column 5, line 56 through column 6, line 30) and to divide, by using *MIME information*, received electronic information composed of a character code into a character code portion and a binary data portion converted into the character code (column 1, line 36 through column 2, line 24), and an error report informing unit adapted to transmit, if an error to be reported to the source occurs during the course of outputting the image data, an error report describing a content of the error by a character code (column 7, lines 20 through 38) corresponding to the detected language type to a source address detected by the content analyzing unit (step 54, column 5, lines 14 through 43, and column 7, lines 22 through 38).

However, Shaffer does not specifically teach if the second determining unit determines whether the non-image data is **convertible into image data**. Further, Shaffer does not specifically teach if the content analyzing unit detects a language type **and an address** of a source from the electronic mail and to divide, by using **MIME header information**.

Saito discloses a communication apparatus (see Figs. 3 and 4) comprising an input unit adapted to input data (interface section 24, column 2, lines 34 through 46), a first determining unit adapted to determine whether the input data is non-image data or image data (column 2, lines 15 through 24), a second determining unit adapted to determine whether the non-image data is convertible into image data (column 2, lines 25 through 29), a processing unit adapted to perform a converting process if the non-image data is convertible (format converting section 26, column 3, line 64 through column 4, line 12), and a content analyzing unit adapted to detect a language type *and an address of a source* from the electronic mail (column 3, lines 5 through 11, and column 4, lines 13 through 19) and to divide, by using *MIME header information*, received

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electronic information composed of a character code into a character code portion and a binary data portion converted into the character code (column 3, lines 5 through 39, and column 4, lines 13 through 53).

Shaffer & Saito are combinable because they are from the same field of endeavor, being systems that receive electronic mail and perform conversion of message attachments. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to include the teachings of Saito in the system of Shaffer. The suggestion/motivation for doing so would have been that Shaffer's system would conform with well known standards of using header information in an electronic mail to identify an attachment's format, as recognized by Saito in column 3, lines 5-11. Therefore, it would have been obvious to combine the teachings of Saito with the system of Shaffer to obtain the invention as specified in claim 69.

Allowable Subject Matter

11. **Claims 7-14, 21-28, 35, 45 and 50** are allowed.
12. The following is a statement of reasons for the indication of allowable subject matter:

Regarding **claims 7, 21, 35, 45, and 50**, in the examiner's opinion, it would not have been obvious to one of ordinary skill in the art to have the systems, as claimed, include the features of determining if the data of a received message is convertible and informing the source of the message of the determination during the same receiving session.

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Conclusion

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joe Pokrzywa whose telephone number is (703) 305-0146. The examiner can normally be reached on Monday-Friday, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (703) 305-4712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Joseph R. Pokrzywa
Examiner
Art Unit 2622



jrj